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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,275	12/30/2003	Robert A. Luciano	83336.0989	9180
66880 7590 12/01/2008 STEPTOE & JOHNSON, LLP 2121 AVENUE OF THE STARS SUITE 2800 LOS ANGELES, CA 90067				
EXAMINER HSU, RYAN				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 12/01/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/750,275

**Applicant(s)**

LUCIANO ET AL.

**Examiner**

RYAN HSU

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 10, 11, 15-17, 20, 23, 24, 29, 33, 36, 39, 41, 43, 46 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 11, 15-17, 20, 23, 24, 29, 33, 36, 39, 41, 43, 46 and 48-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

In response to the amendments filed on 7/24/08, claim 46 has been amended. Claims 1, 10-11, 15-17, 20, 23-24, 29, 33, 36, 39, 41, 43, 46, and 48-56 are pending in the current application.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 10-11, 17, 20, 29, 33, 39, 41, 46, and 48-56 are rejected under 35**

**U.S.C. 103(a) as being unpatentable over Walker et al. (US 6,113,492) and Walker et al. (US 6,068,552) and Wilms (US 5,277,424).**

Regarding claims 1, 20, 33, 41, 46, and 48-56, Walker et al. teaches a gaming method comprising receiving funds from a player for use on a gaming device (*see Fig. 4D and the related description thereof*). Additionally, Walker teaches a gaming device that converts the funds received from the player into credits, wherein each credit has the capability of being a value less than a smallest denomination (*see col. 9: ln 55-67*). Furthermore, Walker teaches the gaming device to display the credits on the gaming device to the player and receive a player's wager, wherein the player wager comprises one or more credits and then presents a game of chance to the player in exchange for the player's wager (*see Fig. 4d-8 and the related description thereof*). Although Walker does not specifically teach the wager value to be smaller than a smallest denomination for standard currency (*ie: as defined by dependent claims 48-56 as*

\$0.01). However Walker does teach the use of fractional coins to be wagered during a game. As taught in Walker, although the amount of coins wagered per play (*ie: a credit*) could be any number of coins as specified by a casino operator...the present invention may also be practiced using fractional coin values". Walker further elaborates on this subject by teaching that fractional amounts may be accumulated in RAM [118] and paid of when a whole coin is reached (*see col. 9: ln 55-67*). Although Walker does not specifically state that each coin less than a standard currency of \$0.01, the teaching of fraction coin values and fraction amounts to be wagered would have allowed one of ordinary skill in the art at the time the invention was made to incorporate these teachings and recognize that fractional amounts meant less than \$0.01 (*ie: or a penny which is the smallest unit available in the U.S. monetary system*). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Walker to recognize a teaching of fractional coins would meet a limitation that a wager value that was smaller than a smallest denomination for standard currency was met by the scope and nature of the disclosure. However, Walker et al. is silent with respect to allowing the player to customize the amount or value of a credit on the game machine would be otherwise known as a "wager amount" (*ie: partial credit values are displayable*).

In an analogous gaming machine patent, Walker teaches the ability for a player to customize player payout, probability, or wager amount (*see Figs. 7 and 9a and the related description thereof*). Walker teaches that a player can customize different parameters and choose how much is wagered by the player during a game (*see Fig. 9a-b and the related description thereof*). One would be motivated to incorporate such a teaching as taught by Walker to offer the player with the flexibility to wager the amount that a player was comfortable to wager and would

therefore increase the comfort and experience of playing the game for the user. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the customization features of Walker with that of Walker to allow for a gaming machine that would allow any monetary amount to be wagered on a gaming machine.

Additionally, Walker teaches a gaming device that allows a user to set a customized wager amount for playing a game of chance. However, Walker and Walker are both silent with respect to teaching a system wherein the standard currency denomination is a coin selected from the group not consisting of \$0.01, \$0.05, \$0.10, \$0.25, and \$1.00.

In a related gaming patent Wilms teaches the ability for a player to choose the amount to be wagered. The standard currency denomination used in Wilms is from a group consisting of an integral multiple of the standard currency denomination or \$0.01, \$0.05, \$0.10, \$0.25, and \$1.00. As an attempt to distinguish from the prior art the applicant's instant invention specifically uses these values as "standard current denominations". The applicant's claims an improvement of providing denominations in currency that are smaller than the standard denomination of that disclosed in Wilms. However it is old and well known in the art that any amount of currency may be wagered by a player for a game (*ie: fractional tickets and wagers made in Congello Jr. (US 6,296,569) and Walker et al. (US 6,267,670) to cite a few examples*). Additionally, Wilms teaches allowing a player to set the amount that each credit would be worth on a wager. Furthermore, under some circumstances, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. In re Dreyfus, 22 CCPA (Patents) 830, 73 F.2d 931, 24 USPQ 52; In re Waite et al., 35 CCPA (Patents) 1117,

168 F.2d 104, 77 USPQ 586. Such ranges are termed "critical" ranges, and the applicant has the burden of proving such criticality. In re Swenson et al., 30 CCPA (Patents) 809, 132 F.2d 1020, 56 USPQ 372; In re Scherl, 33 CCPA (Patents) 1193, 156 F.2d 72, 70 USPQ 204. However, even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. In re Sola, 22 CCPA (Patents) 1313, 77 F.2d 627, 25 USPQ 433; In re Normann et al., 32 CCPA (Patents) 1248, 150 F.2d 627, 66 USPQ 308; In re Irmischer, 32 CCPA (Patents) 1259, 150 F.2d 705, 66 USPQ 314. More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et al., 33 CCPA (Patents) 1250, 156 F.2d 239, 70 USPQ 412; Minnesota Mining and Mfg. Co. v. Coe, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; Allen et al. v. Coe, 77 App. D.C. 324, 135 F.2d 11, 57 USPQ 136. However in the instant example the process of using a credit amount still produces the expected result of the system calculating the amount of credits based on the amount of currency used (*ie: if player places \$1.00 in the machine a credit amount of 100 credits at 0.01 per credit is provided into the user as in Wilms or and in the instant invention if the applicant places \$1.00 he/she will receive 1000 credits at 0.001 per credit as described and attested as applicants 'novel' feature*). This produces the same result and concept taught in Wilms as it is based on the same mathematical principle of how a credit is determined in the gaming industry and as described in the prior art listed to reject the instant invention. Finally, where a claimed improvement on a device or apparatus is no more than "the mere application of a known technique to a piece of prior art ready for improvement." the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI,

2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Therefore the instant invention would have been obvious to one of ordinary skill in the art at the time the invention using the combination of Walker, Walker and Wilms.

Regarding claims 10-11, Walker teaches the wager amount and credits as decimals, which are inherently fractions as decimals are a linear array of digits that represent a real number. For example, decimals typically indicate a negative power of 10 (ie:  $10^{-1} = 0.1 = 1/10$ ) (see display [160] of Fig. 4B and the related description thereof, col. 9: ln 42-67).

Regarding claim 17, Walker teaches a setting to incrementally rate by which the player can increase or decrease the credit value (see '552, col. 5: ln 24-35).

Regarding claim 29, Walker teaches that ability to scale a payable according to the credit value selected by the player (*see col. 9: ln 24-col. 10: ln 20*).

Claim 39, Walker and Walker teach a game machine that comprises a casino marker acceptor and dispenser, which is analogous in the gaming art to a voucher. Therefore it would be a simple matter of design choice for one of routine skill to modify Wilms to allow the use of voucher certificates as opposed to casino markers. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wilms in order to allow for a user to implement a voucher acceptor and printer instead of the casino markers used (*see col. 5: ln 4-27*).

**Claims 15-16, 23-24, 36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and Walker as applied to claims above, and further in view of Skratulia (US 5,690,335).**

With reference to claims 15-16, 23-24, 36 and 43, Walker et al. ('492) and Walker et al. ('552) teach a game machine that accepts vouchers and allows the use of full and partial credits in a wagering game and can store the credit information on a database as discussed above and incorporated herein. However, Walker and Walker lack in specifically disclosing a maximum and minimum credit value for wagering within its game machine. However, it is understood in the gaming arts that casinos will typically setup minimum and maximum wagers or denomination in order to cater to the target clientele. In Skratulia, he teaches the use of an analogous method of playing a wagering game (*see col. 3: ln 20-40*). Skratulia discloses that it would be an obvious matter of design choice for the establishment to set the maximum amount



and that gaming machines are typically adaptable and may be modified to fit the maximum and minimum bets that the casino would like to implement in their machines. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Skratulia with Walker and Walker in order to allow the gaming machine in Walker ('492 and '552) to include a minimum and maximum wager amount.

#### ***Response to Arguments***

Applicant's arguments filed 7/24/08 have been fully considered but they are not persuasive. The applicant's arguments directed towards elements missing in the prior art have been addressed in the modified rejection above. To paraphrase the arguments the KSR v. Telefax standard has been applied to the reference where the applicant has taken a known element and expanded the range with no new unexpected result. As such the arguments presented by the applicant's representative have not been deemed persuasive.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached at (571)-272-4437.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

November 23, 2008

/John M Hotaling II/

Supervisory Patent Examiner, Art Unit 3714